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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,748	08/28/2001	Christopher J. Bradford	IN-5475	5758

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EXAMINER

BERMAN, SUSAN W

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 11/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/940,748

Applicant(s)

BRADFORD ET AL.

Examiner

Susan W Berman

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1711

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 17 October 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 112 rejections.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached page(s).
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-25

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Susan W Berman
Primary Examiner
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Continuation of 10. Other; IDS submitted 06-19--2003 (1 page) and IDS submitted 09-30-2003 (4 pages).

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Applicant's amendments overcome the rejections under 35 USC 112 set forth in the Final Office Action.

Lahrman et al:

Applicant argues that Lahrman et al fails to teach component (a2) having at least two isocyanate-reactive functional groups, no UV curable functional groups and no more than 5% by weight aromatic ring structures. It is noted that claim 1 recites "substantially no functional groups activatable by UV radiation", not "no functional groups" activatable upon exposure to ultraviolet radiation. Lahrman et al teach OH-functional binders and nonaromatic polyisocyanates by references to the disclosure of EP 0 247 563 in column 7, lines 6-11.

Applicant argues that Lahrman et al do not suggest controlling the ratio of NCO groups to the sum of isocyanate-reactive groups so that it is less than 1.30. This argument is not persuasive because the ratio encompasses the normal ratio wherein there is an NCO group for each NCO reactive group to provide reaction between all the NCO groups and all the NCO-reactive groups, as is well known in the art. There is no comparative evidence of record to show unexpected results obtained as a result of controlling this ratio in the instantly claimed invention.

DE 99 141:

Applicant argues that DE '141 does not suggest controlling the ratio of NCO groups to the sum of isocyanate-reactive groups so that it is less than 1.30. This argument is not persuasive because DE '141 discusses the ratio of isocyanate groups and isocyanate-reactive groups. Although the discussion relates to the functional groups in (a1) and (a2) it is the examiner's position that one skilled in the art would have been motivated to employ the same ratio when the isocyanate groups and isocyanate-reactive groups were present in other disclosed components, such as (a1) and/or (a2) in combination with (a5) and (a7). See DE '141, page 23.

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Applicant argues that DE '141 does not motivate one to select isocyanate components. This argument is not persuasive because DE '141 clearly teaches that hydroxyl and isocyanate functional groups are the preferred combination of reactive functional groups. DE '141 teaches that either (a1) or (a2) can have radiation crosslinking groups and optional thermal crosslinking groups. The preferred thermal crosslinking groups are hydroxyl and isocyanate. Component (a5) can be a polyol corresponding to applicant's component (a2). See pages 14-15. Disclosed component (a7) can be a thermally curable binder (pages 18-19) or blocked polyisocyanate (pages 19-20). DE '141 teaches that (a7) must be present if (a1) has no thermally crosslinkable groups, however, (a7) can also be present when (a1) has thermally crosslinkable groups and/or (a2) having radiation crosslinking groups and thermally crosslinking groups can be present when (a1) has only radiation crosslinking groups. Thus, DE '141 teaches components corresponding to each of the instantly claimed components. Applicant has not provided any comparative evidence to show unexpected results obtained from selecting specific species of the components disclosed by DE '141 to refute the obviousness rejection set forth in the last Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.



Susan W Berman
Primary Examiner
Art Unit 1711

SB
10/30/03